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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,322	08/19/2003	James M. Kadushin	374.1.0154	3954

7590 11/20/2006
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EXAMINER
ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,322	Applicant(s) KADUSHIN ET AL.	
	Examiner Lyle A. Alexander	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 further limits the composition of claim 1. However, claim 1 does not describe a composition. It is not clear to what composition claim 12 is directed. For the purposes, these claims will be interpreted as specifying the amount of solvent in the coating composition. The claimed amount of evaporable solvent does not appear to be a structural feature of the instant apparatus because it evaporates and does not require further comment by the Office.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-8 and 12-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) or Lawrence et al. (USP 5,571,684).

The claimed limitations directed to the application of the protective coating do not further structurally limit the instant apparatus claims. The cited prior art is only required

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to teach a protective coating and the method by which the coating is applied is of no patentable moment to the pending apparatus claims. Further, the claimed evaporable solvent does not appear to be a structural feature of the instant apparatus because it evaporates and does not require further comment by the Office.

Gagnon et al. teach a sample holder for infrared spectrophotometric analysis comprising a sample holder(10). Columns 9-10 lines 58-3 teach a sample is applied to the holder(10) as neat or dissolved in a sample where the solvent evaporates. Column 8 lines 46-50 teach a protective cover over the device. Column 21 example "91" teaches the use of acrylic polymers. The claimed "material for supporting" has been read on the taught **sample holder(10)**. The claimed "indicating agent" has been read on the taught **sample**. The claimed "protective coating" has been read on the taught **protective cover**.

Marino teaches a test device(10) comprising a polymer housing(12) encasing/supporting reagent(24) and a cover(52). The claimed "material for supporting" has been read on the taught **polymer housing(12)**. The claimed "indicating agent" has been read on the taught **reagent(24)**. The claimed "protective coating" has been read on the taught **cover(52)**.

Lawrence et al. teach in figure 4 a device comprising a porous sheet(41) supporting reagents(51-53) and protective cover(59). The claimed "material for supporting" has been read on the taught **porous sheet(41)**. The claimed "indicating agent" has been read on the taught **reagents(51-53)**. The claimed "protective coating" has been read on the taught **protective cover(59)**.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barmore et al. (USP 5,483,819).

Barmore et al. (USP 5,483,819) teaches in claims 1-6 a device with an indicator sealed therein. The claimed "material for supporting" has been read on the taught **support**. The claimed "indicating agent" has been read on the taught **indicator**. Claim 6 teaches the "sealant coating or layer" can be ethylene **methyl acrylate** which has been read on the claimed "protective coating".

The claimed limitations directed to the application of the protective coating do not further structurally limit the instant apparatus claims. The cited prior art is only required to teach a protective coating and the method by which the coating is applied is of no patentable moment to the pending apparatus claims. Further, the claimed evaporable solvent does not appear to be a structural feature of the instant apparatus because it evaporates and does not require further comment by the Office.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barmore et al. (USP 5,483,819), Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) or Lawrence et al. (USP 5,571,684) as applied to the claims above, and further in view of Tsao et al. (USP 5,611,464).

See Barmore et al. (USP 5,483,819), Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) and Lawrence et al. (USP 5,571,684) supra.

Barmore et al. (USP 5,483,819), Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) and Lawrence et al. (USP 5,571,684) are silent to the claimed preserving agent naphthalene.

Tsao et al. teach in column 3 lines 61+ that naphthalene is a strong preservative. It is desirable to include preservatives in test compositions to prevent unwanted bacterial growth that could lead to incorrect results.

It would have been within the skill of the art to modify Barmore et al. (USP 5,483,819), Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) or Lawrence et al. (USP 5,571,684) in view of Tsao et al. and include naphthalene preservative to gain the above advantages.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) or Lawrence et al. (USP 5,571,684) as applied to claims 1-2 and 5-8 above, and further in view of Barmore et al. (USP 5,483,819).

Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) and Lawrence et al. (USP 5,571,684) are silent to the use of the claimed "methyl acrylate" polymer for the cover.

The court decided *In re Leshin* (125 USPQ 416) that "Mere selection of known plastics to make a container ...the selection of the plastic being on the basis of suitability for the intended use, would be entirely obvious; and in view of 35 USC 103 it is a wonder that the point is even mentioned".

Barmore et al. (USP 5,483,819) teach **methyl acrylate** is well known in the test device art as a suitable material to construct a container. It would have been within the skill of the art to modify Gagnon et al. (USP 5,470,757), Marino (USP 4,981,653) or Lawrence et al. (USP 5,571,684) in view of Barmore et al. (USP 5,483,819) and use a well known plastic, such as **methyl acrylate** on the basis of its suitability of intended use and in view of *Leshin* above.

Election/Restrictions

Applicant's election without traverse of group I in the reply filed on 9/1/06 is acknowledged.

Claims 17-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/1/06.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1743

